

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 21, 00
UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Janet Wetstone

Serial No. 75/032,568

James W. Hellwege of Jones, Tullar & Cooper, P.C. for
Janet Wetstone.

Andrew P. Baxley, Trademark Examining Attorney, Law Office
114 (Mary Frances Bruce, Managing Attorney).

Before Cissel, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 14, 1995, applicant applied to register
the mark "POTTERY-POWDER" on the Principal Register for
"hydraulically settable powder for use in hobby crafts and
molds," in Class 19. The application was based on
applicant's assertion that it possessed a bona fide
intention to use the mark in commerce in connection with
these goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the proposed mark is merely descriptive of the goods set forth in the application. He also required amendment to clarify the identification-of-goods clause in the application and noted other informalities which required applicant's attention.

Applicant responded to the first Office Action by amending the identification-of-goods clause to read "hydraulically settable powder for use in making items shaped in hobby casts and molds," in Class 16. Other informalities were resolved, and applicant provided argument that the refusal based on descriptiveness was improper.

In addition to its original response, applicant followed up a week later by providing a brochure featuring applicant's products. The Examining Attorney had requested one in the first Office Action. Actually, to be more accurate, the four-page exhibit appears to be an instruction sheet for producing a "FRAME-A-LOT" frame by using a mold, into which a solution which has the consistency of cream is poured. Then the solution is allowed to cure, the mold is removed, and further

instructions describe ways to decorate and use the frames so created.

Every time the term "POTTERY-POWDER" is used in applicant's brochure, it is used as the name for the powder with which water is mixed in order to form the liquid material which is to be poured into the mold. At the beginning of the brochure, when applicant is listing the various "Materials Needed," it lists "POTTERY-POWDER" as one of the necessary items. Step four of the instructions directs the user to "Measure POTTERY-POWDER and sprinkle into water; let stand until saturated, one or two minutes, then gently mix until it reaches the consistency of cream." In the instruction regarding "removing castings from mold," the brochure advises that "self-baking POTTERY-POWDER will become warm and must be allowed to cool before removing from the mold." Under the section labeled "Embedding," "POTTERY-POWDER" is again listed as one of the "materials needed," along with tweezers, toothbrush, damp sand and other items. The reader is instructed to "Mix POTTERY-POWDER as directed in the basic instructions..." and to "pour POTTERY-POWDER mixture over shells..." Then the instructions advise that "The POTTERY-POWDER will settle around the exposed portions of the shells and hold them securely in the finished frame."

Not surprisingly, the Examining Attorney was not persuaded by these examples of applicant's own use of the term that the term sought to be registered is not merely descriptive of them. With his second Office Action, he maintained and made final the refusal to register under Section 2(e)(1) of the Act. Included with the final refusal were excerpts retrieved from seven patents. Each excerpt shows the use of the term "pottery powder," but none of these examples shows the term used in a clear reference to powder used for making molded and cast hobby items such as pottery.

Applicant responded by amending the application to seek registration of the term on the Supplemental Register. Responsive to the amendment, the Examining Attorney refused registration on the Supplemental Register under Section 23 of the Act, on the ground that the proposed mark is generic for the goods set forth in the application, and therefore is incapable of identifying applicant's goods and distinguishing them from similar products produced by others. Attached to this refusal were a number of excerpts from published articles retrieved from the Nexis® database wherein the term "pottery powder" is used. Once again, however, none of this evidence appears to provide a clear

example of use of the term sought to be registered as the generic name for applicant's product.

Applicant filed a response to the refusal to register the mark on the Supplemental Register, but the Examining Attorney responded by making that refusal final under Section 23 of the Act. He argued that the fact that the cited references do not refer specifically to hydraulically settable powder for use in making pottery does not obviate the generic character of the mark, which can be ascertained by reference to the ordinary meanings of the words which are combined to form this composite term. Further, he pointed out that registration on the Supplemental Register is not appropriate prior to the filing of an acceptable amendment to allege use.

Still more excerpts from published articles were included with this final refusal, but these excerpts do not show the term sought to be registered used generically in reference to the goods identified in the application. Instead, they show that "powders" are apparently used to burnish or glaze pottery, and that researchers sometimes scrape away samples of ancient pottery, crush them and analyze the resulting powder to determine the material composition of such archeological discoveries.

Applicant filed a notice of appeal, but the Board pointed out that the refusal of registration based on the lack of acceptable amendment to allege use had only been made one time prior to the notice of appeal. Accordingly, the issuance of the final refusal to register on the Supplemental Register was premature, and the notice of appeal could not be entertained at that time.

The file was forwarded to the Examining attorney for appropriate action. He issued another Office Action, making the refusal of registration under Section 2(e)(1) final and making the refusal to register on the Supplemental Register final on two grounds, namely that the term sought to be registered is incapable of identifying applicant's goods and distinguishing them from those made by others, and that whereas use is a prerequisite to registration on the Supplemental Register, applicant had not submitted an amendment to allege use. Additional excerpts from published articles were appended to this Office Action in an attempt to show that pottery is commonly made from powders shaped in casts and molds. The various excerpts discuss pottery molds for a variety of goods.

Next, applicant filed an amendment to allege use of the term as a mark in interstate commerce in connection

with the specified goods at least as early as March 5, 1999. The required specimens of use of the mark appear to be copies of labels for containers for the goods. Although the heading of the label arguably uses the term as a trademark, further down the label is the following warning: "Caution: Do not put pottery-powder™ in drain."

The Examining Attorney then accepted the amendment to allege use, but maintained the refusals of registration under Lanham Act Section 23. Applicant filed a timely appeal brief and the Examining Attorney filed his responsive brief, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal on its merits based upon the written arguments and materials of record in the application.

After careful consideration of these materials in conjunction with the statute and applicable precedent on these issues, we find that the refusals of record are appropriate because the term applicant seeks to register is generic for powder which is mixed with water and used to make pottery.

A term is unregistrable on the Supplemental Register if it is understood by the relevant purchasing public as a designation which refers to the class of goods or services set forth in the application. *H. Marvin Ginn Corp. v.*

International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). A combination of generic terms that has no separate or distinct commercial impression (i.e., apart from that which one who understands the individual meanings of the component terms would expect the combination to mean) is a generic term, incapable of serving as a source identifier, and therefore unregistrable, even on the Supplemental Register. In re Lowrance Electronics, Inc., 14 USPQ2d 1251 (TTAB 1989). A composite term can be generic without being defined in the dictionary or used by others as a composite term, if the term, as a whole, has no more meaning than the sum of the meanings of each of its constituent parts. In re Gould Paper Corp., 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), our principal reviewing court, in discussing the Gould case, made it clear that its decision there was limited to compound terms formed by the union of words. The compound term found to be generic in that case was "SCREENWIPE," whereas in American Fertility Society, the term the court found not to be generic was "SOCIETY FOR REPRODUCTIVE MEDICINE," which the court held is a phrase consisting of multiple terms which were not joined in any sense other than appearing together as a

phrase. The court reconciled its decision in American Fertility Society with Gould by emphasizing that in both instances, the test remained as enunciated in the Ginn opinion.

In the case at hand, we therefore turn to application of that test. The type or class of goods at issue in the instant case is powders for use in making items shaped in casts or molds by hobbyists. The commonly understood meanings of the words "POTTERY" and "POWDER" support the conclusion that ordinary consumers of craft or hobby kits of the type described in applicant's brochure would understand that the combination of these two words, "pottery" and "powder," or its equivalent, "POTTERY-POWDER," is the name for the type of powder used to make pottery. This situation is analogous to the one in Gould because "POTTERY-POWDER" is a compound term, rather than a phrase consisting of multiple terms, as in the American Fertility Society case.

Applicant contends that the Examining Attorney has not met his burden of establishing the generic nature of the term sought to be registered because none of the materials submitted in support of the refusal to register shows the combined term used as the name for powder which, when

hydrated, becomes the plaster which is poured into the pottery mold.

While applicant may be correct in assessing the evidence submitted by the Examining Attorney, just as in Gould, where the ordinary meanings of the words "screen" and "wipe" led the court to conclude that the compound word "SCREENWIPE" is a generic term, in the case at hand, the ordinary meanings of "pottery" and "powder" lead us to conclude that "POTTERY-POWDER" would be understood by the relevant purchasing public to refer to the genus of goods set forth in this application.

The evidence of applicant's own use of "POTTERY-POWDER" is not inconsistent with this conclusion. That she uses the term as a noun, rather than as an adjective, is not persuasive evidence that the term sought to be registered is likely to be perceived by purchasers of these products as an indication of source.

In summary, consistent with the court's analysis in the Gould decision, supra, we find the term applicant seeks to register here is generic, and hence incapable of identifying applicant's goods and distinguishing them from similar products produced by others. Under these circumstances, registration on the Supplemental Register is clearly not permitted under Section Section 23 of the Act.

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Accordingly, the refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board

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